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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,440	03/12/2004	Marc Shepard	MSFT122465	6241
38991 7590 02/20/2007 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			EXAMINER VY, HUNG T	
			ART UNIT 2163	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/20/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,440	<b>Applicant(s)</b> CHRISTENSEN	
	<b>Examiner</b> Hung T. Vy	<b>Art Unit</b> 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/2/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. As of entry of the amendment filed on 12/07/2006 and 02/05/2007, claims 1-25 are pending in this application. Upon reconsideration, Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection. Applicant's argument about the claims rejection 35 U.S.C 101 is not persuasive (see Applicant's argument below).

#### Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 14 are rejected under 35 U.S.C 101 because the claimed inventions are directed to non-statutory subject matter.

As disclosed in MPEP, Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data (MPEP 2106 (IV) (B) (1)).

In particular, the claimed subject matter of claims 1-25, especially claim 1 and 14 are a data structure, and instead of a physical or logical relationship description among the structure, the limitations are directed to nonfunctional descriptive material: an identifier

element used for uniquely identifying the software update, a localized property element for storing content directed to computer user relating to the software, etc. Therefore, claims 1-25 are rejected because the limitation of the claim is just a mere arrangement of data without creating any functional interrelationship within the data structure.

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter which was not described as a second software update that must be installed before the identified software update is installed.

Claims 6 and 18 depend to claims 5 and 17, therefore these claims 6 and 18 are rejection 112, first paragraph since it fails to resolve deficiencies of claims 5, and 7.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 21, the phrase "may be" renders the claim(s) indefinite because the claim is not clear whether the limitations following the phrase are part of the claimed invention.

Regarding claim 14, line 17, the phrase "may be" renders the claim(s) indefinite because the claim is not clear whether the limitations following the phrase are part of the claimed invention.

Claims 2-13 and 15-25 depend to claims 1 and 14; therefore these claims 2-13 and 15-25 are rejection 112, second paragraph since it fails to resolve deficiencies of claims 1, and 14.

### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 11-15, and 23-25 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Rhoads et al. (U.S. pub. No. 2005/0213790).

Regarding claims 1 and 14, best understood, Rhoads et al. discloses a computer-readable medium storing computer-readable data organized in a tag-based data structure (i.e., "Header (XML format)"(0667)) for communicating update metadata (i.e., "metadata")(0447)) corresponding to a software update (i.e., "update software installed on

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*device”(0459)) comprising: an identifier element (i.e., “the handler 16 may identify a URL corresponding to the water mark (using the database 17)”(0458 or 0553)) used for uniquely identifying the software update (i.e., “software updates”(0458)); and at least one additional element of the following elements: a handler element (i.e., “the handler 16”(0459)) storing information for executing the update handler identified in the property elements (i.e., “the handler may have some locally stored and sent it to the device 12 response to the watermark”(0458-0459)) for installing the identified software update (i.e., “to update software installed on device 12”(0458-0459)), wherein the at least one additional element (16) describing pertinent aspects of the identified software update (based on the identify a URL corresponding to the water mark) is useful for determining the value and applicability of the identified software update such that communication resources may be preserved in not obtaining the identified software update if the identified software update is of no value or inapplicable for installation on a computing system (i.e., “to update software installed on device 12”(0458-0459)).*

Regarding claims 2 and 15, Rhoads et al. discloses the tab-based data structure is an XML data structure (i.e., “Header (XML format)”(0667)).

Regarding claim 3, Rhoads et al. discloses at least one-addition elements are logically ordered according to the above-described order (0458-0459).

Regarding claims 4 and 16, Rhoads et al. discloses the identify element includes a unique identifier that uniquely identifies the software update, and revision number associated with the software update (0559-0561).

With respect to claims 11-13 and 23-25, Rhoads et al. discloses the file element includes information identifying the software update's payload (*i.e.*, *payload*" (0457)) for patching excising files on a client computer (*i.e.*, *originating device*" (element 12, *fig. 2*)).

6. Claims 1 and 14 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Melchione et al. (U.S. pub. No. 2004/0073903).

Regarding claims 1 and 14, best understood, Melchione et al. discloses a computer-readable medium storing computer-readable data organized in a tag-based data structure (*i.e.*, *"XML"*(0061)) for communicating update metadata (*i.e.*, *"xml"*(0060-0061)) corresponding to a software update (*i.e.*, *"update software is valid"*(0076)) comprising: an identifier element (*i.e.*, *"the key may comprise a token identifier, and may be associate with a defined group of computers in the organization"*(0013), or *"where the key is a globally unique identifier (GUID). The URL 1210 can then provided to a nodes in an organization with which the user is associated, or to nodes in some other organization"* (0096)) used for uniquely identifying the software update (*i.e.*, *"software updates"*(0096)); and at least one additional element of the flowing elements: a rule element (*i.e.*, *"Policies"* (0110)) string rules for determining the applicability of software update to a client computer (*i.e.*, *"the policy can include a stage of software to be distributed to nodes associated with the policy"* (0110)), a relationship element (*i.e.*, *"register a node for software administration"* (0116)) storing relationship the software update has to other software updates, wherein the at least one additional element (*i.e.*, *"Policies"* (0110)) describing pertinent aspects of the identified software update (based on the identify a token) is useful for determining the value and applicability of the identified software update (*i.e.*, *"when a request for software associated with a token is received by a data center"* (0117)) such that

communication resources may be preserved in not obtaining the identified software update if the identified software update is of no value or inapplicable for installation on a computing system (i.e., *"if an agent at a node request a software update, the node identifiers will place the node into its proper group and software to be distributed to the group can be provided"*(0122-0123)),.

### **Claim Rejections - 35 U.S.C. § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-10 and 16-22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rhoads et al. (U.S. pub. No. 2005/0213790) in view of Melchione et al. (U.S. Pub. No. 2004/0019889).

With respect to claims 5-10 and 16-22, Rhoads et al. discloses all limitations recited in claim 3 and 14 except for prerequisite information and a plurality software update that must be installed coextensively. However, Melchione et al. discloses for prerequisite information and a plurality software update that must be installed coextensively (see fig. 8 and 0057). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al.'s invention by adding the code for relationship for prerequisite information and the code for information of relationship element of a plurality software update that must be installed



coextensively in order to have facilitate efficient and effective update of firmware and/or software in update or distribution environment for the stated purpose has been well known in the art as evidenced by the teaching of Melchione et al (Melchione et al., 0011-0013)

### **Response to Arguments**

9. Applicant's arguments about the rejection 101 filed on 02/05/2007, page 13 have been fully considered but they are not persuasive because the claims recite "at least one additional element of the following elements" so the handler or payload are not necessary as requirement in claims. At least one-addition elements can be as the rule or relationship the software update. Therefore, the claims are direct to computer user relating to the software per se, the claims cannot be categorized in one of the statutory categories of invention and is thus nonstatutory.

### **Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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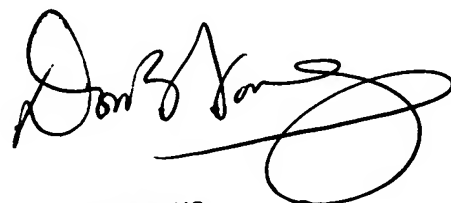
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 4, 2007  
H.V

A handwritten signature in black ink, appearing to read "Don Wong", with a large, stylized loop at the end.

DON WONG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100